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| In re Application of | : | SEP 15 2005 |
| Locht et al. | : | |
| Patent No.: 6,841,358 B1 | : | |
| Application No. 08/765,287 | : | OFFICE OF PETITIONS |
| International Filing Date: | : | |
| April 19, 1995 | : | DECISION |
| 371 Date: September 12, 1997 | : | ON PETITION |
| Title of Invention: RECOMBINANT | : | |
| PROTEINS OF FILAMENTOUS | : | |
| HAEMAGGLUTININ OF BORDETELLA, | : | |
| PARTICULARLY BORDETELLA PERTUSSIS, | : | |
| METHOD FOR PRODUCING SAME, AND USES | : | |
| THEREOF FOR PRODUCING FOREIGN | : | |
| PROTEINS OF VACCINATING ACTIVE | : | |
| PRINCIPLES | : | |

This is a decision in response to the Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b), filed January 10, 2005. The delay in treating this petition is regretted.

The petition under 37 CFR 1.137(b) is hereby granted.

Background:

Applicant filed a Request for Continued Examination (RCE) under 37 CFR 1.114 on March 26, 2001, in the above-identified application, which is the National Stage of an International Application filed on April 19, 1995. The RCE was improper because the provisions of 37 CFR 1.114 do not apply to an international application filed under 35 U.S.C. 363 before June 8, 1995. See 37 CFR 1.114(e)(3).

A request for continued examination is not a type of new application filing. See Request for Continued Examination Practice and Changes to Provisional Application Practice, Final Rule, 65 Fed. Reg. 50092, 50097 (August 16, 2000). The Office cannot convert an improper RCE to an application, such as a continuing application under 37 CFR 1.53(b) or (d). An improper RCE will not operate to toll the running of any time period set

in the previous Office action for reply to avoid abandonment of the application. See Manual for Patent Examining Procedure (MPEP) 706.07(h), page 700-70, subsection III.A., "Treatment of Improper RCE", (8th Ed. 2001).

In the instant case, a final Office action was mailed on September 26, 2000. Under 35 U.S.C. § 133, an applicant has six (6) months to reply to an Office action. Upon failure to prosecute the application within six months of notice of the Office action, the application shall be regarded as abandoned. This statutory requirement may not be waived by the Office. The filing of the improper RCE on March 26, 2001 did not toll the time period set forth in the Office action mailed on September 26, 2000. Thus, the application became **abandoned on March 27, 2001** for the failure to reply to the final Office action mailed on September 26, 2000.

The Office, however, mistakenly treated the improper RCE as a proper RCE and reopened the prosecution of the application. A Supplemental Response was filed July 13, 2001. A non-final Office action was mailed on December 18, 2001. A response to the non-final Office action was filed on April 18, 2002. A final Office action was mailed on August 13, 2002. A Notice of Appeal and extension of time request were filed on December 13, 2002. An Amendment was filed on March 13, 2003. An Advisory Action was mailed on April 22, 2003. A second improper RCE was filed on June 13, 2003. A non-final Office action was mailed on September 23, 2003, and a response to the non-final Office action was filed on January 23, 2004.

Petition to Revive


Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after the applicants become aware of the abandonment and must be accompanied by: (1) the required reply, unless previously filed, (2) the petition fee required by law, (3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional", and (4) a terminal disclaimer (and fee set forth in § 1.20(d)) is required pursuant to paragraph (d) of this section (for applications filed before June 8, 1995).

Applicants have satisfied Items (1) through (4). With regard to subsection (4), since the above-identified application is a utility application filed before June 8, 1995, 37 CFR 1.137(d)

requires a terminal disclaimer dedicating to the public a terminal part of any term of any patent granted on the above-identified application or any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the above-identified application. The period to be disclaimed will be a terminal part of the patent to be granted equivalent to the period of abandonment. The period of abandonment will be computed to be the number of months lapsed from the date of abandonment to the date when this application issued as a patent. A terminal disclaimer fee of \$130 is required and has been provided. The terminal disclaimer filed on January 10, 2005, has been accepted.

All of the requirements of 37 CFR 1.137(b) have now been met. Accordingly, applicants' petition to revive under 37 CFR 1.137(b) is granted.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.


Derek L. Woods

Attorney/Advisor
Office of Petitions